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TM

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/064,765 04/23/98 OHNISHI

H 381TO/41092R

PM82/0802
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EXAMINER

ZANFELLI M	
ART UNIT	PAPER NUMBER

3661
DATE MAILED:

10
08/02/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/004,765

Applicant(s)

Ohnishi et al

Examiner

Zemelli

Group Art Unit

3661

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

☒ Responsive to communication(s) filed on 6/30/19

☒ This action is **FINAL**.

- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-12 is/are pending in the application.

Of the above claim(s) _____ is/are withdrawn from consideration.

☒ Claim(s) 1-7 is/are allowed.

☒ Claim(s) 8-12 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 8
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

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DETAILED ACTION

1. This is responsive to the amendment filed 6/30/99. Claims 1-12 are currently pending.
2. The IDS filed 6/30/99 has been considered.
3. The drawings have been transferred from the patent filed as requested.
4. This application stands objected to under 37 CFR 3.73(b) as lacking evidence of the right of the assignee to take action. See MPEP § 324.

A proper assent of the assignee in compliance with 37 CFR 3.73(b) is required in reply to this Office action. To date no assent has been received.

5. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting an essential step, such omission amounting to a gap between the steps. See MPEP § 2172.01. The omitted step is: comparison of the ratio between turbine revolution speed and engine revolution (N_t/N_e) and a threshold value (i.e., 0.8) (see Fig. 12:1202; col. 8, lines 19 *et seq.*). The only time that a deviation (i.e. accessory torque) is calculated is if a comparison step determines the ratio N_t/N_e is less than a threshold value. The method as claimed performs the calculation and correction steps without any consideration as to the ratio as disclosed. Applicant has not disclosed an embodiment in which this step is omitted.
6. Claims 8-11 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: *unit for* comparing the ratio between turbine revolution speed and engine revolution (N_t/N_e) and a threshold value (i.e., 0.8) (see Fig.

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12:1202; col. 8, lines 19 *et seq.*). First, although the claims are not written in the classical “means for” format, §112/6th para. is invoked since the claims set forth functions without specific structures for performing the functions. See *Al-Site Corp. v. VSI Int’l, Inc.* (CAFC March 1999) 50 USPQ2d 1161, 1167. As noted above with regards to method claim 12, applicant does not disclose an embodiment in which a torque estimating unit does not include the comparing “unit”. See col. 7, lines 39 *et seq.*.

7. **REMARKS**

A. With regards to the citation of *In re Clement* on page 6 of the response, the recapture rule was not triggered by reclaiming deliberately canceled subject matter, but by the arguments presented during prosecution in distinguishing over the prior art.

Thus, as noted in the first Office action, *Hester Industries, Inc. v. Stein, Inc.* (CAFC, May 7, 1998) (46 USPQ2d 1641) is the applicable law.

B. With regards to the Exhibits presented showing the reasons why the torque estimating system/method was itself novel without the weight estimation means and running load estimation means, the examiner acquiesces to this argument and hereby withdraws the recapture rule rejection. However, the claims as currently pending do not reflect the language recited in the wherein clauses of patented claim 1, 5, 6, and 7, the reasons for allowance stated by the examiner (Exhibit A), or the argument highlighted in Exhibit C. In each instance, reference is made to the ratio (i.e. N_t/N_e) used in determining how the estimated torque is to be calculated and subsequently

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corrected. Thus, applicant's arguments do not find basis in the claims as currently pending.

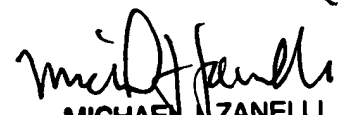
8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Michael Zanelli** whose telephone number is **(703) 305-9756** (M-Th, 6:30-5:00 PM).

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is **(703) 308-1113**.

/mjz
July 29, 1999


MICHAEL J. ZANELLI
PRIMARY EXAMINER